

REMARKS

The Office requires confirmation of the election of the species of Figures 1 and 3 that was made via telephone on August 28, 2005.

Applicants confirm the election of the species shown in Figures 1 and 3. This election is made without traverse. Claims 1 to 4, 6 and 8 are directed to the elected species.

The abstract of disclosure is objected to because the abstract uses terminology such as "means" which is considered to be "legal" phraseology.

The abstract has been amended to delete the terminology "means". Removal of the objection to the specification is in order.

The Office notes that claims 1-4 and 6 contain means plus function language and is taking the position that the applicant is invoking 35 U.S.C. § 112, sixth paragraph, and that the means recited are the means described in the specification. The significance of this position is believed to be that certain means described in the cited prior art (discussed below) are considered by the Office to be equivalent to the means described in the specification for performing the functions recited in the claims and, therefore, are considered to be within the scope of the

claims. However, for the reasons explained below, the means described in the cited prior art do not perform the functions of the means recited in the claims and are not equivalent to said means.

Claims 1-4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell (U.S. Patent No. 2,471,623) in view of Berrigan (U.S. Patent No. 6,319,245). Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell and Berrigan and further in view of Burke et al. (U.S. Patent No. 4,038,982; hereinafter: "Burke"). The position of the Office in these rejections is that Hubbell discloses an apparatus that includes each of the elements/means recited in claim 1 except that Hubbell does not disclose "opening/closing clamps" (i.e., opening/closing means). Berrigan is cited as supporting the obviousness of adding opening/closing means as well as control means to the apparatus of Hubbell.

Applicants respectfully submit that the Office's interpretation of the apparatus of Hubbell and the allegation of obviousness of modifying the apparatus of Hubbell are not correct.

First, The bulb (B) in Hubbell is not a "liquid medicine pressurizing/supplying means for exerting pressure on a liquid medicine and causing the liquid medicine to flow through a first

passage" as recited in the claims of the application and as described in the specification of the present application because the bulb (B) does not itself exert pressure on a liquid medicine and cause the liquid medicine to flow through a first passage. It is the hand of the operator that exerts pressure on a liquid in bulb (B) and forces it through conduit (D). The hand of the operator, or the combination of bulb (B) and the hand of the operator, cannot reasonably be considered to be equivalent to the liquid medicine pressurizing/supplying means described in the specification.

Second, control (C) of Hubbell cannot reasonably be considered to be a secondary liquid medicine pressurizing means as recited in claim 1 of the application. The control (C) does not receive an increment of liquid medicine from a liquid medicine pressurizing/supplying means and exert a pressure on the liquid medicine that is lower than the pressure exerted on the liquid medicine by the liquid medicine pressurizing/supplying means as described in the specification of the present application. However, to ensure that the function of the secondary liquid medicine pressurizing means of the liquid medicine infusion apparatus of the present invention is properly interpreted, claim 1 of the application has been amended to recite that the function

of the secondary liquid medicine pressurizing means is to temporarily store the liquid medicine supplied from the liquid medicine pressurizing/supplying means and to force the liquid medicine through the downstream passage. (See paragraph [0019] of the specification of the present application). The control (C) of Hubbell simply opens and closes conduits (S) and (D) of the apparatus for handling fluids disclosed therein and does not store the liquid nor force it through conduit (D).

Third, a person of ordinary skill in the art would not have been motivated to modify the apparatus of Hubbell to include opening/closing means as well as control means. The apparatus of Hubbell is intended to be operated using one hand and could not be properly operated using opening and closing means upstream and downstream of the control (C) as required by the claims of the application.

For the above reasons, Hubbell, alone or combined with Berrigan, fails to support a case of *prima facie* obviousness of claims 1-4 and 6 of the application and removal of the 35 U.S.C. § 103(a) rejection is in order.

Regarding the rejection of claim 8, the rejection of claims 1-4 and 6 over Hubbell in view of Berrigan has been shown to be improper. Therefore, the rejection of claim 8, which depend on

PATENT APPLN. NO. 10/684,495
RESPONSE UNDER 37 C.F.R. §1.111

PATENT
NON-FINAL

claim 1, over Hubbell in view of Berrigan and further in view of Burke is also improper.

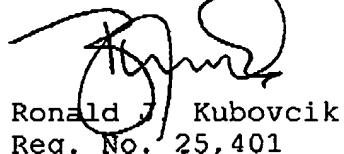
A notice of allowability of claims 1-10 is believed to be in order and is respectfully requested.

The foregoing is believed to be a complete and proper response to the Office Action dated November 15, 2005, and is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,
KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik
Reg. No. 25,401

Atty. Case No. NPR-128
The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006
Tel: (202) 887-9023
Fax: (202) 887-9093
RJK/jbf